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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/506,992 | 04/12/2005 | Yoshiyuki Udagawa | 258513US0PCT | 1958 |
| 22850 | 7590 | 09/25/2009 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER | | | | |
| PAK, HANNAH J | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1796 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 09/25/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/506,992

Applicant(s)

UDAGAWA ET AL.

Examiner

Hannah Pak

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-11, and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicants' amendment/remarks filed on 06/29/2009.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.
4. The examiner assigned to the current application has been changed. The new examiner's name and contact information are stated at the end of this action. Applicant is requested to take note of the change

Claim Rejections - 35 USC § 102

5. Claims 1, 2, 5-10 are rejected under 35 U.S.C. 102(a) as being anticipated by KONDO (US 6,727,307).

The discussion of the disclosure of KONDO from paragraph 5 of the office action dated 1/22/08 is incorporated here by reference.

6. Claims 1, 2, 5-11, 13-19 are rejected under 35 U.S.C. 102(e) as being anticipated by KONNO (US 2004/0030027)

The discussion of the disclosure of the teachings of KONNO from paragraph 6 of the office action dated 1/22/08 is incorporated here by reference.

Claim Rejections - 35 USC § 103

7. Claims 1, 2, 4-11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over GORL (US 6,882,036) in view of KONDO (EP 1,219,676) and evidentiary teachings of THIBON (US 1,656,250).

The discussion of the disclosure and the prior art of GORL with evidentiary teachings of THIBON as disclosed in paragraph 11 of the office action dated 1/22/08 is incorporated here by reference.

Response to Arguments

8. The applicants' arguments filed 06/26/2009 are fully considered but are not found persuasive. Specifically, the applicants argue that **(A)** Konno and Kondo references fail to disclose mixing the inorganic filler with a compound having a carboxyl group, and then combining that mixture with the diene rubber (see Pages 8-9 of the Applicants' Remarks). The applicants also argue that **(B)** Gorl reference fails to disclose or suggest mixing the inorganic filler having a carboxyl group (see Page 9 of the Applicant's Remarks). Thus, there is no motivation in Gorl, Thibbon and Kondo to particularly use an anionic surfactant having a carboxyl group or a fatty acid salt. Those skilled in the art also cannot expect the effect to be achieved with an anionic surfactant having a carboxyl group or a fatty acid salt in place of polyethylene ether.

With respect to argument **(A)**, on Table 3 in Col. 16, Kondo discloses adding stearic acid along with inorganic filler dispersion and diene rubber. In addition, on Table 20, paragraph 174 of Konno, Konno teaches usage of stearic acid, wherein stearic acid

comprises carboxyl group, added together with a inorganic filler and then with a diene rubber. Thus, the references above do anticipate the claimed process.

With respect to argument **(B)**, the examiner would like to draw applicant's attention to Col. 6, lines 45-47 of GORL, where it is clearly indicated that rubber emulsion or solution is mixed with filler suspension. The addition is also evidenced in the example I of Gorl. In addition, the prior art of Kondo discloses surfactants suitable for use in rubber emulsions. These surfactants are listed in paragraph 49, wherein emulsifier and surfactant mean the same. The surfactants or emulsifiers of Kondo are the same type as those required by the instant invention. Thus, it would have been obvious to one having ordinary skill in the art at the time of the instant invention to utilize surfactants or emulsifiers of Kondo to form suspension of Gorl and thereby obtain the claimed invention. The emulsifiers of Kondo are also known as surfactants. They contain both hydrophilic and hydrophobic components and are therefore capable of forming suspension or emulsion. Such modified process will also provide rubber comprising inorganic filler of the instant invention.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hannah Pak

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Art Unit: 1796

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Examiner
Art Unit 1796

/HP/

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796